

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

82-017 4239

UNIVERSAL CITY STUDIOS, INC.,

Plaintiff,

82 Civ. \_\_\_\_\_

-against-

NINTENDO CO., LTD. and  
NINTENDO OF AMERICA, INC.

Defendants.

COMPLAINT

JUDGE JARRET

JUN 29 2 14 PM '82

U.S. DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

Plaintiff Universal City Studios, Inc., by its attorneys, Townley & Updike, for its complaint against defendants Nintendo Co., Ltd. and Nintendo of America, Inc., herein alleges as follows:

PARTIES AND JURISDICTION

1. Plaintiff Universal City Studios, Inc. (herein "Universal") is a corporation organized under the laws of the State of Delaware, having its principal place of business at 100 Universal City Plaza, Universal City California. Universal maintains an office at 445 Park Avenue, in the City and County of New York.

2. Upon information and belief, defendant Nintendo Co., Ltd. is a corporation organized under the laws of Japan which, with respect to the matters complained of herein, transacts and does business in the State of New York.

3. Upon information and belief, defendant Nintendo of America, Inc. is a corporation organized under the laws of the State of New York, with an office at 1107 Broadway, New York, New York.

4. This is a civil action arising under the trademark laws of the United States, 15 U.S.C. §§1051, et seq., and under the laws of the State of New York. The matter in controversy exceeds the sum or value of \$10,000, exclusive of interest and costs, and the Court has subject matter jurisdiction over the claims asserted under the federal trademark laws by virtue of 28 U.S.C. §1338(a) and 15 U.S.C. §1121 and jurisdiction over the claims asserted under the laws of the State of New York by virtue of 28 U.S.C. §1338(b) and principles of pendent jurisdiction. Venue is placed in the Southern District of New York under 28 U.S.C. §§1391(b) and 1400(a).

5. Plaintiff Universal through its "Universal Pictures" division is engaged generally in the business of producing and distributing motion pictures for theatrical and other types of exhibition in the United States and throughout the world. Through its corporate affiliate, Merchandising Corporation of America, Inc. (herein "Merchandising") Universal is also engaged generally in the business of licensing the use of various Universal trademarks, service marks, symbols, trade names and characters owned by Universal for the use by others in connection with the sale of articles of merchandise and services.

6. By virtue of certain agreements and written assignments entered into between Universal and RKO General Inc. and Universal and the heirs of Merian C. Cooper, Universal is the owner of all trade name, trademark, service mark and other rights in the name, character and story of KING KONG, created and developed by Merian C. Cooper prior to 1933 and produced and released as a motion picture under the name "KING KONG" by RKO Radio Pictures Inc. in 1933, and subsequently as a remake

motion picture under that name by Dino De Laurentiis Corporation in 1975.

7. During the 1960's RKO licensed the production of other motion pictures featuring the character KING KONG, one entitled "KING KONG VERSUS GODZILLA," a second entitled "KING KONG ESCAPES" and an animated television series entitled "THE KING KONG SHOW."

8. The name KING KONG denotes a gigantic gorilla and the story of KING KONG, as made popular by the story of Merian C. Cooper and motion pictures of RKO and Dino De Laurentiis to whose rights in KING KONG Universal has succeeded, tells of the gorilla's discovery by an American movie crew on an island in the South Pacific, his subsequent capture and transport to New York and the gorilla's attachment for the female star of the film. Among the most popular and famous scenes of the "KING KONG" motion pictures produced by RKO and Dino De Laurentiis is KING KONG at the top of a large building holding the female lead of the film captive while attempting to repel the efforts of others to rescue her.

9. Both the RKO 1933 and Dino De Laurentiis 1975 "KING KONG" motion pictures were extensively advertised and promoted throughout the United States and both are currently offered for sale and rental to the public in the form of video cassettes. Both motion pictures have achieved and enjoy enormous nationwide popularity and commercial success the 1933 RKO "KING KONG" having been continuously exploited by RKO and its licensees for the past 49 years and the 1975 remake "KING KONG" having been continuously exploited by RKO licensees for the past 7 years, through theatrical and television exhibition

10. In addition to the foregoing efforts to commercially develop and exploit the KING KONG name in motion

pictures, RKO and its KING KONG licensees have continuously used in interstate commerce the name KING KONG, the character KING KONG and elements of the KING KONG story in association with the other motion pictures and television shows as previously described and in the advertising and sale of consumer products and services, including various toys, posters and sundry items.

11. As a result of the extraordinary popularity and commercial success of the original 1933 "KING KONG" motion picture, the KING KONG motion pictures of the 1960's, the "KING KONG" remake motion picture of 1975 and the KING KONG television shows and consumer products licensed by RKO Pictures and RKO, and the extensive advertising and promotion undertaken in connection therewith, the KING KONG name, character and story, including the visual image of a giant gorilla atop a tall building, have become, and are, well known to the public, and are associated and identified by the public with their creators to whose rights therein Universal has succeeded, is now owner and has expanded upon as described infra

12. As a result of the foregoing activities, the name KING KONG, the gorilla character KING KONG and visual image of KING KONG atop a large building have acquired a secondary meaning with the public in connection with motion pictures, television shows and consumer products and services, including especially products and services in the entertainment fields, all of which the public identifies as deriving from a single origin and source.

13. Universal has recently expanded on the promotional and commercial efforts of its predecessors with respect to KING KONG by licensing the KING KONG name and KING KONG character to Tiger Electronics, Inc., for use by the latter in the

manufacture and sale of a home video game and cassette which feature the KING KONG name and character of the gorilla KING KONG.

COUNT ONE

14. Upon information and belief, defendants, and each of them, manufacture, distribute and sell in interstate commerce in the United States a certain coin operated video arcade game which bears the name DONKEY KONG. The screen of defendants' DONKEY KONG game depicts a giant gorilla atop a large building of girders holding as captive a young female hostage, in a manner reminiscent and suggestive of the exploits of the KING KONG gorilla made famous by the KING KONG motion pictures. The object of defendants' DONKEY KONG arcade game is for the player to activate a man up through a series of girders to the top of a building where defendants' DONKEY KONG gorilla holds the female hostage while the man avoids obstacles thrown in his way by the KONG gorilla. A panel of the game upon which playing instructions are given states in part: "Save the lady from DONKEY KONG."

15. Defendants' coin operated video arcade game DONKEY KONG as thus described incorporates, uses, copies and features the KING KONG name, or elements thereof, the KING KONG gorilla character and the visual image of KING KONG atop a building, all of which are property and trademarks of Universal.

16. Upon information and belief, defendants developed their DONKEY KONG game by deliberately copying elements of the KING KONG name, character and visual image, with the intention of deliberately misappropriating and trading upon the popularity of Universal's property and trademark rights in KING KONG.

... and the elements of the KING KONG story made popular by the "KING KONG" motion pictures as aforesaid is without Universal's consent or permission and without the consent or permission of any of Universal's predecessors in interest.

18. Universal has given formal notice to defendants of Universal's trademark rights as aforementioned, and has demanded of defendants that they cease and desist from their use of the KING KONG name, character and visual image in violation of Universal's rights. Defendants have refused to so cease and desist, and have continued to engage in the foregoing conduct with actual knowledge of Universal's rights, and with the intent to cause confusion and mistake among the public as to the source and origin of their DONKEY KONG video arcade game.

19. Upon information and belief, defendants are attempting to pass off their DONKEY KONG game as a KING KONG game and to trade upon the popularity, goodwill, and commercial efforts of Universal and its predecessors with respect to the name KING KONG.

20. Defendants' manufacture, distribution and sale of their video arcade game under the name DONKEY KONG with its KING KONG gorilla and elements of the KING KONG story as previously described constitute the false designation by defendants of the origin of their product and the false description and the making of false representations by defendants about their product, in violation of Section 43(a) of the Trademark Act of 1946, 15 U.S.C. §1125(a), in that such actions falsely suggest to the public that defendants' product originates with or is authorized, sponsored or approved by the owner of the KING KONG name, character and story

21. As a result of the foregoing, Universal, as owner of the KING KONG name, character and story, has sustained and will continue to sustain irreparable injury.

22. Unless enjoined and restrained by this Court, defendants will persist in the manufacture, advertisement, sale, offering for sale, and distribution of their arcade game DONKEY KONG, thereby causing Universal further irreparable injury.

23. Universal has no adequate remedy at law.

COUNT TWO

24. Universal repeats and realleges each and every allegation of paragraphs 1 through 19 of this complaint as if fully set forth herein.

25. The aforesaid acts and conduct of defendants have misled the public and have caused public confusion and are likely to continue to mislead and cause public confusion and to deceive and mislead the public into believing that the game DONKEY KONG originates with, is sponsored by, or is otherwise authorized or approved by Universal as the owner of the name, character and story KING KONG or a party acting on Universal's behalf or for its benefit with respect to said name, character and story.

26. Defendants' manufacture, advertisement, sale, offering for sale, and distribution of the arcade game DONKEY KONG has caused and will continue to cause a likelihood of confusion among the public as to the source, origin, authorization, sponsorship, and approval of said arcade game and constitutes an infringement by defendants of Universal's



common law trademark rights in the name KING KONG and in the KING KONG character and story.

27. As a result of the foregoing, Universal, as owner of the KING KONG name, character and story, has sustained irreparable injury.

28. Unless enjoined and restrained by this Court, defendants will persist in the manufacture, advertisement, sale, offering for sale, and distribution of their arcade game DONKEY KONG, thereby causing Universal further irreparable injury.

29. Universal has no adequate remedy at law.

COUNT THREE

30. Universal repeats and realleges each and every allegation of paragraphs 1 through 19 of this complaint as if fully set forth herein.

31. Defendants' manufacture, advertisement, sale, offering for sale, and distribution of the game DONKEY KONG are likely to damage Universal's business reputation and will dilute the distinctive quality of the KING KONG name, character and visual image in violation of Universal's rights under N.Y. Gen. Bus. Law § 368-d.

32. As a result of the foregoing, Universal, as owner of the KING KONG name, character and story, has sustained and continues to sustain irreparable injury.

33. Unless enjoined and restrained by this Court, defendants will persist in the manufacture, advertisement, sale, offering for sale, and distribution of the game DONKEY KONG, thereby causing Universal further irreparable injury.



34. Universal has no adequate remedy at law.

COUNT FOUR

35. Universal repeats and realleges each and every allegation of paragraphs 1 through 19 of this complaint as if fully set forth herein.

36. Defendants' use of the KING KONG name, character and visual image in connection with the manufacture, advertisement, sale, offering for sale, and distribution of the game DONKEY KONG constitutes unfair competition and misappropriation by defendants to their own use and benefit of the valuable good will, reputation, and business properties developed by Universal and Universal's predecessors in interest.

37. As a result of the foregoing, Universal, as the owner of the KING KONG name, character and story, has sustained and continues to sustain irreparable injury

38. Unless enjoined and restrained by this Court, defendants will persist in the manufacture, advertisement, sale, offering for sale, and distribution of the game DONKEY KONG, thereby causing Universal further irreparable injury.

39. Universal has no adequate remedy at law.

COUNT FIVE

40. Universal repeats and realleges each and every allegation of paragraphs 1 through 19 of this complaint as if fully set forth herein.

41. The aforesaid use of the name DONKEY KONG by defendants in the manner alleged herein constitutes an infringement of the trade name of KING KONG.

42. As a result of the foregoing, Universal, as owner of the KING KONG name, character and story, has sustained and continues to sustain irreparable injury.

43. Unless enjoined and restrained by this Court, defendants will persist in the use of the words DONKEY KONG as a trade name, thereby causing Universal further irreparable injury.

44. Universal has no adequate remedy at law.

WHEREFORE, Universal prays:

1. That defendants be adjudged to have competed unfairly with plaintiff, engaged in unfair business practices, and used false descriptions, designations of origin and representations about their product all in violation of state and federal law.

2. That defendants and their respective officers, agents, servants, employees, and all persons acting or claiming to act on their behalf or under their direction or authority, and all persons acting or claiming to act in concert or in participation with them or any of them, be permanently and mandatorily enjoined and restrained as follows:

(a) From using on or in connection with the manufacture, sale, offering for sale, advertisement, labelling, or packaging of any articles of merchandise, any colorable imitations of the name, character or visual image of KING KONG or anything confusingly similar thereto, including the trade name DONKEY KONG, unless such uses have been licensed by Universal;

(b) From representing by any method whatsoever that any articles of merchandise sold by defendants originate

with, are authorized, sponsored or approved by Universal or its licensees, unless such articles of merchandise have been licensed by Universal, or from otherwise taking any action likely to cause confusion, mistake, or deception on the part of the public as to the origin, authorization, sponsorship or approval of such goods;

(c) That defendants, within 15 days from the date of an injunction, send to each distributor, jobber, wholesaler, retailer, or other customer to whom defendants have within the past year delivered merchandise bearing the name DONKEY KONG a letter by certified mail effecting retrieval of all such merchandise by issuance of a credit, notifying such customer of the injunction;

(d) That defendants withdraw with prejudice all applications for registration of the name DONKEY KONG as a trademark or trade name or service mark or service name and that defendants take such steps as may be necessary to abandon all registrations heretofore granted;

3. That defendants be required to deliver up to the Court, or to some other person that the Court may designate, for ultimate destruction, any and all articles of merchandise in their possession or control or that of their owners, officers, agents, servants or employees, or in the possession or control of any of their distributors or representatives which might, if used, sold or distributed for sale, violate the injunction granted herein;

4. That Universal have an accounting of defendants, for the profits arising from the sale of all DONKEY KONG games and related merchandise and that in accordance with such accounting, and in light of defendants' intentional and willful

nduc., that Universal be awarded an amount equal to three times said profits, together with interest thereon;

5. That Universal have a judgment against defendants, in an amount equal to three times Universal's damages resulting from injury to Universal's business relationship and injury to its good will and reputation, caused by defendants' intentional and willful conduct, together with interest thereon;

6. That Universal be awarded punitive damages, reasonable attorneys' fees and disbursements, as authorized under 15 U.S.C. § 1117, in view of defendants' intentional and willful conduct; and

7. That Universal have such other and further relief as this Court may deem just and proper.

Dated: New York, New York  
June 29, 1982

Yours, etc.,

TOWNLEY & UPDIKE

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